

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

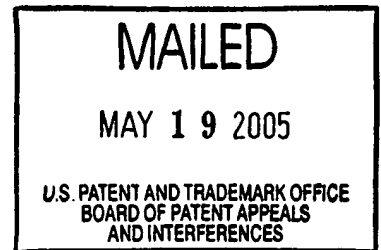
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY S. WALKER, MAGDALENA MIK,
DANIEL E. TEDESCO and DEAN ALDERUCCI

Appeal No. 2005-0253
Application No. 09/267,489

HEARD: May 5, 2005



Before HAIRSTON, LEVY, and MACDONALD, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-50¹, which are all of the claims pending in this application.

¹ The examiner indicates (answer, page 3) that claims 5-7, 18-20, 31-34, 43, 45 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. In view of the examiner's withdrawal of the rejection of claims 5-7, 18-20, 31-34, 43, 45 and 46, only claims 1-4, 8-17, 21-30, 35-42, 44 and 47-50 remain before us for decision on appeal.

BACKGROUND

Appellants' invention relates to systems and methods for selecting direct-marketing mailing lists. Specifically, the system and method provides a mailing list testing service wherein a plurality of mailing lists are tested. To perform a test, a computer-based message, such as an electronic mailing (e-mail) is sent to each of a subset of list members for each mailing list. At least one response from a list member is received, and based on the received responses, one of the mailing lists is selected for use in a postal mailing campaign (specification, page 3). A further understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A method for providing a mailing list test service involving a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member, the method comprising:

(a) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;

(b) receiving a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from one of the subsets of list members; and

(c) selecting for use, based on the responses received in (b), one of the plurality of postal mailing lists.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Druckenmiller et al. (Druckenmiller)	6,167,435	Dec. 26, 2000 (filed Oct. 30, 1998)
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McEvoy et al. (McEvoy)	6,292,785	Sep. 18, 2001 (filed Feb. 19, 1999)
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Interactive Marketing News v3, "How to Generate Online Leads from the Web", n.10, May 10, 1996

Claims 1-4, 8-12, 14-17, 21-25, 27-30, 35-42, 44 and 47-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Druckenmiller in view of Interactive Marketing News and "Applicant's own admission²."

Claims 13 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Druckenmiller in view of Interactive Marketing News and McEvoy.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 28, mailed July 13, 2004) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 27, filed March 2, 2004) and reply brief (Paper No. 29, filed June 17, 2004) for appellants' arguments thereagainst. Only those

² Answer, page 3.

arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, for the reasons set forth by appellants. We begin with claim 1. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in .

Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroval, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 3 and 4) is that Druckenmiller teaches sending an automated verification e-mail message to a mailing list member and receiving a response, and that Druckenmiller teaches selecting a mailing list from a plurality of mailing lists according to a demographic product, etc. The examiner acknowledges that Druckenmiller does not disclose a postal mailing address, but takes the position that using a postal address as a correlation to an e-mail address "is an obvious choice relative to a demographic profile." The examiner further asserts (answer, page 4) that Druckenmiller does not disclose sending an e-mail message to the person on the list, but that it would be obvious to combine the teachings of Druckenmiller and Interactive Marketing News because (answer, page 5) "using email [sic: e-mail] to verify postal addresses and to further target recipients provides good leads and increases potential profitability." With regard to the selection of one or more mailing lists over another, the examiner takes the position that since appellants admit that choosing a proper mailing list is crucial, that basing the selection on responses from a sent e-mail would be an obvious modification of Interactive Marketing News.

Appellants assert (brief, page 19) that the examiner has failed to establish a prima facie case because there is no showing that the references suggest "*selecting for use a postal mailing list from a plurality of postal mailing lists.*"

Appellants further assert (brief, page 18) that "[t]he references further fail to suggest sending an e-mail message, for each of a plurality of mailing lists, to each of a subset of the list members of any kind of mailing list, much less sending the e-mail message to subsets of postal mailing list members." It is argued (id.) that the examiner's assertions do not address the particular limitations of claim 1, and that (brief, page 20) the examiner does not in any instance tie any of the assertions about what the prior art discloses to a particular claim limitation.

Appellants state that:

In particular, Examiner does not assert that the prior art suggests alone or in combination, *selecting for use a postal mailing list from a plurality of postal mailing lists based on responses to an e-mail message, where the e-mail message had previously been sent, for each of the plurality of postal mailing lists, to each of a subset of the list members.* For example, there is no discussion in the rejection of claim 1 why it would be obvious to use e-mail messages to 'pre-test' the effectiveness of postal mailing lists, even though the genres of e-mail mailing lists and postal mailing lists were considered separate fields with no consistent and

reliable correlations between postal mailing addresses and e-mail addresses of recipients of a single list prior to Appellants' invention.

Appellants argue (brief, page 21) that the examiner's assertion that Druckenmiller discloses sending an e-mail to a member of an e-mail mailing list and receiving a response does not address the limitation that the e-mail message is sent, for a plurality of postal mailing lists, to each of a subset of list members. Appellants add (id.) that in Druckenmiller, the adding of a user's name to a list is not done based on responses to an e-mail message that was sent, for each postal mailing list in a plurality of postal mailing lists, to each of a subset of list members. It is further argued (brief, page 22) that Interactive Marketing News does not disclose sending an e-mail message to a potential lead that requests the potential lead, to verify a postal mailing address. In addition, Interactive Marketing News does not disclose selecting a postal mailing list from a plurality of mailing lists, based on responses to an e-mail.

Appellants further assert (brief, page 28) that the examiner's stated motivation for combining the teachings of Druckenmiller and Interactive Marketing News fails for the reasons that "(a) the motivation is not found in the prior art; (b) the motivation would not actually have prompted one to make

the proposed combination; and c) the combination does not have anything to do with the embodiment of claim 1." It is additionally argued (brief, page 32) that:

Simply put, in Druckenmiller there is no description of *selecting for use any mailing list of a plurality of mailing lists, much less of selecting for use a postal mailing list of a plurality of postal mailing lists, much less of selecting for use a postal mailing list of a plurality of postal mailing lists based on responses to an e-mail message, much less of selecting for use a postal mailing list of a plurality of postal mailing lists based on responses to an e-mail message that was sent, for each of the plurality of postal mailing lists, to each of a subset of list members.*

From our review of Druckenmiller and Interactive Marketing News, we agree with appellants, for the reasons which follow, that Druckenmiller and Interactive Marketing News are directed to methods for creating or compiling mailing lists, and not to a method of selecting, for use, a mailing list from a plurality of mailing lists. Druckenmiller is directed to a Double Opt-In™ method and system for verifying subscriptions to information distribution services. An electronic address mailing system is generated wherein potential subscribers access an Internet site and voluntarily subscribe to one or more mailing lists by entering their e-mail address and selecting one or more areas of

interest. Once a subscription request is received, an alphanumeric token is generated and associated with the e-mail address. Next, an automated verification is generated and sent to the e-mail address to confirm the subscription. The subscription is not considered valid until confirmed by a response that contains both the e-mail address and the unique token. When a response containing both the e-mail address and the unique token is received, the subscription is confirmed and the subscriber information is added to the subscription lists (col. 1, line 66 through col. 2, line 23); see figure 4A. From the disclosure of Druckenmiller, it is clear that Druckenmiller is directed to the creation of an electronic distribution list, by using a double opt-in by subscribers to lessen the likelihood that an uninterested person is put on the subscriber list. Thus, Druckenmiller is not directed to testing of postal lists to determine which list to select. Specifically, Druckenmiller does not teach or suggest "sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members, as recited in claim 1."

Druckenmiller does not teach or suggest at least clauses (a) and (c) of claim 1. The examiner's assertions (answer, pages 3 and 4) that "[s]ending an automated verification email message to the

mailing list member and receiving a response from the member (column 2, lines 10-19). Selecting a mailing list from a plurality of mailing lists according to a demographic, product, service, or other relevant subject" are misplaced, as the assertions are inconsistent with the limitations of claim 1, and do not address much of the language of the claim limitations. Although Druckenmiller discloses (col. 7, lines 18-22) that demographic information can be included in the mailing list, as asserted by the examiner (answer, page 4), Druckenmiller does not disclose or suggest sending an e-mail to each of a subset of the members of one of the postal lists. Nor does Druckenmiller disclose or suggest selecting one of the plurality of postal lists, based on the responses received, because Druckenmiller is directed to creating an electronic mailing list, not to selecting one of a plurality of postal lists.

From our review of Interactive Marketing News, we find that the reference does not make up for the deficiencies of Druckenmiller. The reference is directed to information on generating online leads from the web. The reference discloses using responses to target advertisements to a subset of users, and also discloses having fields for users to request to be put on postal mailing lists, as well as teaching that having an

e-mail or postal address for follow up will increase the chances of closing the sale. However, the reference is not directed to sending an e-mail to a subset of members of a postal list, receiving responses, and selecting one of the plurality of postal lists based on the responses received. Thus, Interactive Marketing News does not make up for the deficiencies of Druckenmiller. In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves (attached to decision). Accordingly, we agree with appellants (reply brief, page 5) that:

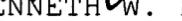
none of the references teach (i) selecting a postal mailing list from a plurality of postal mailing lists, nor (ii) sending an e-mail message to a subset of list members for each postal mailing list in a plurality of postal mailing lists, nor (iii) selecting the postal mailing list from the plurality of postal mailing lists based on the responses to such an e-mail message.

From all of the above, we find that the applied prior art falls far short of establishing a prima facie case of obviousness of claim 1. The rejection of claim 1 under 35 U.S.C. § 103(a) is


reversed. As independent claims 14, 27 and 39 contain similar limitations, the rejection of claims 14, 27, and 39, along with dependent claims 2-4, 8-12, 15-17, 21-25, 28-30, 35-38, 40-42, 44 and 47-50, dependent therefrom, is reversed.

We turn next to the rejection of claims 13 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Druckenmiller in view of Interactive Marketing News and McEvoy. We cannot sustain the rejection of claims 13 and 26 because McEvoy does not make up for the deficiencies of the basic combination of Druckenmiller and Interactive Marketing News. Accordingly, the rejection of claims 13 and 26 under 35 U.S.C. § 103(a) is reversed.

To summarize, the decision of the examiner to reject claims 1-3, 8-17, 21-30, 35-42, 44 and 47-50 under 35 U.S.C. § 103(a) is reversed.


KENNETH W. HAIRSTON
Administrative Patent Judge

Stuart S. Levy
STUART S. LEVY
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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